

REMARKS

In the Office Action dated October 28, 2005, the Examiner rejected claims 1-4 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Stock et al.* (U.S. Patent No. 6,011,858) in view of *Tanaka et al.* (U.S. Patent No. 5,682,549). By this Amendment, Applicants have added new claims 19 and 20. As such, with entry of this Amendment, claims 1-4, 16, 19, and 20 remain pending in this application. Based on the following remarks, Applicants respectfully traverse the rejections of claims 1-4 and 16. Applicants respectfully disagree with the Examiner's arguments and conclusion and respectfully submit that a *prima facie* case of obviousness has not been established.

In order to establish a *prima facie* case of obviousness, at a minimum, the references must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Independent claim 1 recites, *inter alia*:

memory means for storing move/copy history indicative of the movement of a particular file when the particular file is moved/copied from said large capacity memory means to a non-volatile memory;

Claim 16, although of different scope, recites similar subject matter.

The Examiner asserts that the above claim recitation is taught by *Stock et al.* and cites col. 2, lines 14-21, col. 5, line 66 - col. 6, line 1, and col. 4, lines 28-36. (See *Office Action*, page 3). However, such an assertion is incorrect. *Stock et al.* discloses a programmable memory card capable of holding a user's personal information, which is stored in a security file structure and protected through biometric verification. (See *Stock et al.*, Abstract.) Specifically, as is evident from the above passages relied on by the Examiner, *Stock et al.* discloses a memory card 20 that is capable of storing the

user's personal information, wherein the user information is stored on the memory card 20 by utilizing an application file structure 24. However, such file structure 24 is a conventional file structure that simply stores data. (See *Stock et al.*, col. 4, lines 33-36 and col. 4, lines 56-59). In other words, *Stock et al.* fails to disclose wherein file structure 24 is capable of "storing move/copy history indicative of the movement of a particular file... ."

Also, the Examiner's reliance on the cited definition of "transaction" is misplaced. (See *Office Action*, page 3). *Stock et al.* discloses the capability to store credit card transactions onto the memory card 20. (See *Stock et al.*, col. 6, lines 5-12). It appears that the Examiner has attempted to equate the term "transactions" with the above claim recitation. However, as used by *Stock et al.* the term "transactions" is limited to consumer transactions, and in particular, to credit card transactions. (See *Stock et al.*, col. 5, line 66 - col. 6 line 1.) Specifically, the stored information relating to the transaction is limited to information that may be found on a printed consumer receipt. (See *Stock et al.*, col. 6, lines 1-12.) And although the credit card "transaction" of *Stock et al.* may be used as an "audit trail" or a "history" of the transaction, the "transaction" itself is certainly not "indicative of the movement of a particular file... .," as recited in independent claims 1 and 16.

Further, Applicants do not dispute that the memory card 20 of *Stock et al.* may store information other than those related to consumer transactions. *Stock et al.* explicitly states that the memory card 20 may be used for "medical information applications, security access applications, and other information applications." (*Stock et al.*

al., col. 2, lines 50-54.) Nevertheless, nowhere does *Stock et al.* disclose “storing move/copy history indicative of the movement of a particular file...,” as recited in independent claims 1 and 16.

Moreover, the “transaction” of *Stock et al.* cannot be equated to the claimed “history indicative of the movement of a particular file” because nowhere does *Stock et al.* disclose a “control means for prohibiting the particular file from being moved/copied from said large capacity memory means to the non-volatile memory when said reference means has detected that the history information is stored in said memory means,” as recited in independent claims 1, and similarly in independent claim 16. Instead, *Stock et al.* only discloses that the storage and access to data on the memory card 20 is limited to biometric verification. (See, e.g., *Stock et al.*, col. 4, lines 56-59.) Therefore, the “transaction” of *Stock et al.* does not itself “prohibit[] a particular file from being moved/copied,” as recited in independent claims 1 and 16.

Lastly, *Tanaka et al.* does not cure the deficiencies of *Stock et al.* *Tanaka et al.* discloses an image data management system for storing and organizing scanned image data. (See *Tanaka et al.*, Abstract.) Indeed, the Examiner applies *Tanaka et al.* for the purported disclosure of a “large capacity memory means for storing a plurality of files.” (Office Action at page 5.) Nothing in *Tanaka et al.* discloses the missing claim elements of independent claims 1 and 16 as discussed above.

Thus, *Stock et al.* and *Tanaka et al.* taken alone or in combination fail to teach all the limitations of independent claims 1 and 16. For at least this reason, the cited prior art fails to establish a *prima facie* case of obviousness regarding independent claims 1

and 16. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claims 1 and 16 under 35 U.S.C. 103(a) and the timely allowance of the claims. Dependent claims 2-4, 19, and 20 are allowable at least for the reasons set forth above in connection with independent claims 1 and 16. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 2-4, 19, and 20 under 35 U.S.C. 103(a) and the timely allowance of the claims.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-4, 16, 19, and 20 in condition for allowance. Applicants submit that newly added dependent claims 19 and 20 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since they incorporate all of the elements previously submitted in respective independent claims 1 and 16. Therefore, this Amendment should allow for immediate action by the Examiner.

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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